



PATENT
Customer No. 22,852
Attorney Docket No. 3806.0532-00

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)
Chin-Wen CHI et al.) Group Art Unit: 1614
Application No.: 10/083,565) Examiner: J. Goldberg
Filed: February 27, 2002)
For: USE OF DOCETAXEL FOR)
TREATING HEPATOCELLULAR)
CARCINOMA)

Commissioner for Patents
Washington, DC 20231

Sir:

RESPONSE TO RESTRICTION REQUIREMENT

This paper is responsive to the Office Action mailed June 6, 2002, which set a shortened statutory period for response of one month, the period ending July 6, 2002.

As July 6, 2002 is a Saturday, this Response is timely filed on July 8, 2002.

Restriction Requirement

In the Action, the Office required restriction under 35 U.S.C. § 121 between:

Group I: claims 6-12 and 16-22, indicated as being drawn to a composition and method for treating hepatocellular carcinoma in a patient employing docetaxel; and

Group II: claims 13-15, indicated as being drawn to treating hepatocellular carcinoma employing an enhanced combination of the Group I invention and another therapy.

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Election with Traverse

In response, Applicants provisionally elect to prosecute Group I, claims 6-12 and 16-22, with traverse.

The Office states that the Groups represent inventions that are independent and distinct, as having acquired separate status in the art of treating hepatocellular carcinoma as a separate subject matter for inventive effect. The Office asserts that the Groups would require independent searches. The Office also asserts that the claims read on a multitude of enhanced combinations of drugs, which would require many fields of searches, placing an undue burden on the Examiner. Applicants respectfully submit that while searching the subject matter of the additional three claims (13-15) of Group II might cause some additional burden, it would hardly be undue.

For example, it is respectfully submitted that the subject matter of all pending claims is sufficiently related that a thorough search of the subject matter of Group I would encompass a search for the subject matter of the three remaining claims (Group II). Thus, a search and examination of the non-elected subject matter with that of Group I would not place a *serious* additional burden on the Examiner. Section 803 of the M.P.E.P. states that "if the search and examination of the entire application can be made without serious burden, the Examiner *must* examine it on the merits" (emphasis added). It is respectfully submitted that this policy should apply in the present application in order to avoid unnecessary delay and expense to Applicant and duplicative examination by the Patent Office.

Thus, Applicant respectfully requests that the Examiner withdraw the restriction requirement and consider claims 13-15 together with claims 6-12 and 16-22.

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Please grant any extensions of time required to enter this response and charge
any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: July 8, 2002

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